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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,783	09/12/2003	Werner Honegger	P56949	5861

7590 05/30/2006
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EXAMINER

MORRISON, THOMAS A

ART UNIT	PAPER NUMBER
3653	

DATE MAILED: 05/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/660,783

Applicant(s)

HONEGGER, WERNER

Examiner

Thomas A. Morrison

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 17-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>09/12/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Groups I-III in the reply filed on February 27, 2006 is acknowledged. The traversal is on the ground(s) that the fields of search overlap and there is no serious burden on the examiner to examine all of the claims. This is not found persuasive because, while some of the searching may overlap, the searches for the method claims and the different apparatus claims are not the same. It is a serious burden on the examiner to search for all of the different claimed inventions, such as the claims directed only to the guide and the claims directed to the method of processing and separating sheets. Claims 17-31 have been withdrawn from further consideration as being directed to a non-elected invention.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims contain numerous lack of antecedent basis problems and indefiniteness problems.

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For example, claim 1 recites the limitation "the items" in line 2. There is insufficient antecedent basis for this limitation in the claim.

As another example, claim 3 recites the limitation "the guide means" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim.

As another example, claim 4 recites the limitation "their cut-edge side" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim.

As another example, claim 4 recites the limitation "their cut-edge side" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim.

As yet another example, claim 7 recites the limitation "their main conveying direction" in line 2. There is insufficient antecedent basis for this limitation in the claim.

As another example, it is unclear in claim 8 what is meant by the recited "after this" in line 2. After what element is the transfer module arranged?

In claim 9 it is unclear if the guide surface is concave, convex, has sections with different inclinations, or some combination of these different limitations.

These indefiniteness problems are merely exemplary. Applicant should review claims 1-16 and make the language consistent throughout the claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 5 and 6-16, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,334,890 (Bombard).

Regarding claim 1, Figs. 1-6 disclose a method for processing and separating an imbricate formation of flexible, flat objects during product feed, comprising continuously feeding the items (30) in an essentially regular formation to a transfer module (including 121) and transferring the items from the transfer module (including 121) to a conveyor module (including 54), wherein flat objects (30) are fluently fed to a guide (including 141 and 142) within the transfer module (including 121), and the flat objects (30) during their conveying are brought into an obliquely standing position (Fig. 2) by the guide (including 141 and 142), and that the flat objects (30) from this position are separated in a defined number (e.g., one at a time) from the remaining flat objects by a separator (54), and conveyed away by a conveyor (including 109).

Regarding claim 5, column 4, lines 41-52 and lines 64-72 disclose that the erection of the flat objects (30) is effected by active braking or acceleration of the flat objects (30) at least one edge by way of conveyor means (including 125).

Regarding claim 6, in as much as the device of the instant application has a folding-over means, so does the Bombard apparatus. In particular, whatever structure causes the sheets to be folded over from lying flat to an upright position can be considered folding over means.

Regarding claim 7, Fig. 2 shows that the flat objects (30) before removal are displaced transversely to their main conveying direction (i.e., left to right in Fig. 2).

Regarding claim 8, Figs. 1-6 show a device for carrying out the method according to claim 1 with a product feed, comprising a conveyor means (including 47) with a transfer module (including 121) arranged after this and with a conveyor module (including 54) for removal of flat objects (30) from the transfer module (including 121);

wherein the transfer module (including 121) contains a guide means (including 141, 142, 133 and 134) which comprises a guide surface which at least in regions is inclined with respect to the horizontal (Fig. 2), and that on the side proximal to the removal device there is arranged a brim or abutment (141 or 142).

Regarding claim 9, Figs. 1-6 show that the guide surface (including contact surfaces of 133, 134, 141 and 142) at least in regions is designed comprises at least two sections with a different inclination of the guide surface.

Regarding claim 10, Figs. 1-6 show that the inclination of the guide surface at least in regions is more than 30 degrees. For example, a portion of the guide surface on 133 is vertically oriented (approximately 90 degrees).

Regarding claim 12, Figs. 1-6 show that the brim or the abutment (141 or 142) is arranged movable with respect to the guide means (including 141, 142, 133 and 134).

Regarding claim 13, on the side of the guide means (including 141, 142, 133 and 134) which is proximal to the removal device (including 54), there are arranged active means for separating individual objects or groups of objects. See e.g., column 4, lines 41-52 and lines 64-72.

Regarding claim 14, column 4, lines 41-52 and lines 64-72 disclose that the brim or the abutment (141 or 142) comprises movable elements conveying the objects in the removal direction (i.e., up).

Regarding claim 15, Fig. 1 shows that in the removal region of the objects, there are arranged means for transversely displacing the objects.

Regarding claim 16, Fig. 1 shows that above the guide means, there are arranged retaining means (including 95) acting on the free edge of the objects.

With regard to claim 11, different elements are cited for the brim or abutment. Thus, all of the elements of claims 8 and 11 are included in the rejection of this claim, as outlined below.

Regarding claim 11, Figs. 1-6 show a device for carrying out the method according to claim 1 with a product feed, comprising a conveyor means (including 47) with a transfer module (including 121) arranged after this and with a conveyor module (including 54) for removal of flat objects (30) from the transfer module (including 121);

wherein the transfer module (including 121) contains a guide means (including 141, 142, 133 and 134) which comprises a guide surface which at least in regions is inclined with respect to the horizontal (Fig. 2), and that on the side proximal to the removal device there is arranged a brim or abutment (133 or 134). Also, the guide surface comprises guide elements (141 and 142) which serve for the regional acceleration and/or braking of the flat objects. See also column 4, lines 41-52 and lines 64-72 for an explanation of the acceleration of the flat objects.

4. Claims 1-3 and 6, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,934,666 (Rabindran et al.).

Regarding claim 1, Figs. 1 and 7a-7d and column 5, lines 54-62 disclose a method for processing and separating an imbricate formation of flexible, flat objects during product feed, comprising continuously feeding the items (36) in an essentially regular formation to a transfer module (38) and transferring the items from the transfer module (38) to a conveyor module (column 5, lines 58-62), wherein flat objects (36) are fluently fed to a guide (near 306) within the transfer module (38), and the flat objects (36) during their conveying are brought into an obliquely standing position (Figs. 7c and 7d) by the guide, and that the flat objects (36) from this position are separated in a defined number from the remaining flat objects by a separator (at 38), and conveyed away by a conveyor (column 5, lines 58-62).

Regarding claim 2, Figs. 7b-7d show that the flat objects (36) are fed onto a guide surface of the guide (near 306) and are conveyed lying in an overlapping manner, wherein the trailing edge of a flat object in each case lies over the leading edge of the subsequent flat object (Fig. 7b), and the objects (36) during the transport over the guide surface are continuously erected, whereby on removal of the flat objects from the guide the obliquely standing position of the flat objects (36) is inclined opposite to a direction of the conveyance (left to right).

Regarding claim 3, Figs. 7a-7d and column 5, lines 43-50 disclose that the flat objects are folded sheets (e.g., envelopes or magazines), wherein the fold of each

folded sheet in a trailing manner lies over a respective subsequent folded sheet and the folded sheets which stand obliquely on removal from the guide means stand on their cut-edge side.

Regarding claim 6, in as much as the device of the instant application has a folding-over means, so does the Rabindran et al. apparatus. In particular, whatever structure causes the sheets to be folded over in the different positions shown in Figs. 7a-7d can be considered folding over means.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Bombard patent. The Bombard patent discloses most of the limitations of claim 3 including the fact that the objects can be folded paper boxes (i.e., folded sheets). See, e.g., column 1, line 13. Also, as best understood, Fig. 2 shows that a sheet can in a trailing manner lie over a respective subsequent sheet and the sheets stand obliquely on removal. However, the Bombard patent does not specifically disclose the arrangement of the fold of each sheet, as set forth in claim 3. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the folded boxes with the fold lying over the respective subsequent folded sheet and

with the cut-edge sides facing downward so as to prevent jamming, which may occur when the cut-edges rather than the folded end face upward when the sheets are removed upward by the Bombard apparatus. More specifically, arranging the fold in this manner would prevent fanning out and possible jamming of the cut edge during removal by the Bombard apparatus.

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Rabindran et al. patent. The Rabindran et al. patent discloses most of the limitations of claim 4 including the fact that the objects can be envelopes and magazines (i.e., folded sheets). See, e.g., column 5, lines 40-53. Also, as best understood, Figs. 7a-7d show that a sheet can in a trailing manner lie over a respective subsequent sheet and the sheets stand obliquely on removal. However, the Rabindran et al. patent does not specifically disclose the arrangement of the fold of each sheet, as set forth in claim 4. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the folded sheets with the fold lying over the respective subsequent folded sheet and with the cut-edge sides facing downward so as to prevent jamming, which could possibly occur when the cut-edges rather than the folded end face of a magazine are located near the removal device of the Rabindran et al. apparatus.

Conclusion

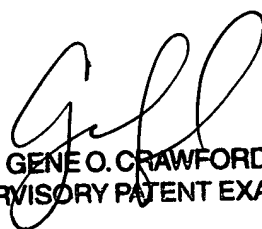
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Morrison whose telephone number is (571) 272-7221. The examiner can normally be reached on M-F, 8am - 5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on (571) 272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

05/15/2006


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